REMARKS

The following is responsive to the Patent Office Action mailed September 7, 2005. However, the rejection is not fully understood. The "Disposition of Claims" states that claims 1 to 21 are rejected, but claim 12 is not rejected, but objected to on informalities on page 2. The informalities are corrected by this Amendment. Further, the Office Action further states that claim 18 would be allowed if rewritten in independent form. Claim 17, which has been amended to include the limitations of claim 18, is thus believed to be in condition for allowance.

The Applicant further respectfully traverses the **Double Patenting Rejection** on page 2 of the Office Action because the claims in this application are clearly patentably distinct from the claims in co-pending application Serial No. 10/439,526. However, if the non-statutory double patenting rejection is continued and this application is allowed, an appropriate Terminal Disclaimer will be filed.

Claims 1, 3 and 6 were rejected by the Examiner as 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,340,251 of ***Takahashi, et al.*** in view of the disclosure of U.S. Patent No. 6,318,940 of ***Mitts***. The Applicant respectfully traverses this rejection for the reasons set forth hereinbelow. Further, claims 2 and 7 were rejected under 35 U.S.C. § 103(a) as unpatentable over "modified" ***Takahashi*** as applied to claims 1 and 3 and further in view of the disclosure of U.S. Patent No. 2,037,586 of ***Olson***. It is assumed that the "modified Takahashi" is the ***Takahashi, et al.*** patent in view of the teaching of ***Mitts***. The Applicant also respectfully traverses this rejection.

The ***Takahashi, et al.*** patent assigned to the predecessor in interest of the assignee of this application discloses a self-attaching fastener having a central pilot portion 15, an annular flange portion 29, an annular groove 16 surrounding the pilot portion having a cylindrical outer wall 20 and a flange portion includes a frustoconical outer surface 18. The bottom wall 26a of the groove includes annular arcuate spaced protuberances 24a to 24b and the outer wall of the

annular groove includes radial notches 30a to 30d. In an alternative embodiment shown in Figure 5, the outer wall of the annular groove is polygonal. Anti-rotation or torque resistance is provided by the radial notches or the polygonal configuration of the outer wall, not the protuberances. The protuberances deform the panel metal during installation beneath the frustoconical outer wall 18 of the pilot portion. The torque resistance is provided by the radial notches 30a to 30d.

The ***Mitts*** patent discloses a self-locking or self-attaching fastener including a radial flange portion 20 having a polygonal "locking insert 24," and a radial flange portion 20 having "gripping means 22" shown in Figures 3 and 6 comprising radial teeth or sharp edges 32 which bite into the panel and forces the panel into the slots 33 as shown in Figure 6. The self-attaching fastener disclosed in the ***Mitts*** patent does include an annular groove 26 as shown in Figure 4. However, the teeth 32 are ***not located in the groove 26***, but are located on the surface of the radial flange as shown in Figure 3.

The Applicant respectfully submits that it would ***not be obvious*** to combine the teaching of the ***Mitts*** patent with the ***Takahashi, et al.*** patent. Further, if the teaching of the ***Mitts*** patent were combined with the disclosure of the ***Takahashi, et al.*** patent, a person of ordinary skill in the art would eliminate the radial notches 30a to 30d or the polygonal surface shown in Figure 5 and provide radial teeth as disclosed in the ***Mitts*** patent on the annular bearing face 29 of the radial flange portion as shown in Figure 2 of the ***Takahashi, et al.*** patent. Further, it would not be obvious to combine the teaching of the ***Mitts*** patent with the disclosure of the ***Takahashi, et al.*** patent because the method of installing the self-attaching nut disclosed in the ***Takahashi, et al.*** patent would be ***completely unsuitable*** for the gripping means 22 disclosed in the ***Mitts*** patent. In the method of installing the self-attaching fastener disclosed in the ***Takahashi, et al.*** patent, the pilot portion pierces the panel as shown in Figure 10 and the fastener 10 is then driven against a die member 52 having a projecting lip 62 which drives the

panel metal into the annular groove and against the arcuate protuberances 16 as shown in Figure 11 and the protuberances then guide the panel metal beneath the inclined inner side wall as shown in Figure 13 and into the radial notches as shown in Figure 16. In the method of installing the self-attaching nut disclosed in the ***Mitts*** patent, the pilot portion is deformed radially outwardly and against the radial teeth on the flange portion by the die member 38 as shown in Figure 5. Thus, it would be contrary to the teaching of the ***Takahashi, et al.*** patent to replace the radial notches in the outer wall of the annular groove with the radial teeth on the top surface of the annular flange portion as taught by the ***Mitts*** patent.

The ***Olson*** patent discloses a locking nut or screw having radial teeth similar to the ***Mitts*** patent wherein the clamping surface 34 includes a plurality of circumferentially spaced locking sections 36 which are canted relative to the locking surface to bite into the mating surface of the part which receives the nut or screw. These radially extending canted surfaces comprise teeth as disclosed in the ***Mitts*** patent or may take various forms as disclosed in the several embodiments disclosed in the ***Olson*** patent. Again, however, the Applicant respectfully submits that it would not be obvious to combine the teaching of the ***Olson*** patent with the disclosure of the ***Takahashi, et al.*** patent because (1) the proposed combination would result in radial teeth on the panel bearing surface as discussed above with regard to the ***Mitts*** patent, and (2) the combination would be contrary to the teaching of the ***Takahashi, et al.*** patent.

Claim 1 of this application has been amended to more clearly define the self-attaching fastener of this invention, wherein the ***bottom wall of the annular groove*** includes a "first plurality of circumferentially spaced anti-rotation elements each having a ***planar radially extending top face***" spaced above a plane of the bottom wall of the annular groove and a "second plurality of circumferentially spaced radial anti-rotation elements each having a ***planar radially extending top face*** spaced below the plane of the bottom wall of the annular

groove." As set forth above, it would not be obvious to combine the teaching of the ***Mitts*** patent with the disclosure of the ***Takahashi, et al.*** patent and the combination would not result in the self-attaching fastener set forth in claim 1. However, even if the references were combined as suggested by the Examiner, the "gripping elements 22" disclosed in the ***Mitts*** patent would not be located in the ***bottom wall of the groove*** and further, the radial teeth disclosed in the ***Mitts*** patent do not include a "***planar radially extending*** top face." Similarly, the proposed combination of ***Olson, Mitts*** and ***Takahashi, et al.*** would not result in this invention as defined in claim 1.

It is noted that claims 4, 5 and 8 to 21 ***were not rejected*** based upon the prior art cited, but were rejected only based upon the judicially created doctrine of non-statutory double patenting. As set forth above, the Applicant respectfully submits that the claims of co-pending application Serial No. 10/439,526 do not anticipate or make obvious the specifically claimed subject matter of this application. Therefore, the Applicant respectfully requests the Examiner to withdraw this rejection. However, if the rejection is continued and the claims of this application are allowed, the Applicant will file an appropriate Terminal Disclaimer.

Claim 11 similarly claims the anti-rotation elements as including "planar ***radially extending*** top face(s)" including a first plurality having a planar radially extending top face ***inclined radially upwardly***" from the bottom wall toward one of the inner and outer side walls having an end surface spaced above the planar bottom wall and a second plurality of circumferentially spaced anti-rotation elements each having a "planar ***radially extending*** top face ***inclined radially downwardly***" from the bottom wall toward the other of the inner and outer side wall having an end face spaced below the bottom wall of the annular groove. The Applicant respectfully submits that neither of the ***Mitts*** patent nor the ***Olson*** patent disclose anti-rotation elements as specifically defined in claim 11. The locking elements disclosed in the ***Mitts*** and ***Olson*** patents are not located in the bottom wall of the groove and the locking

elements do not have a "planar radially extending top face" and the sharp edges or teeth disclosed in these patents do not have a top face which extends radially upwardly or radially downwardly. Thus, although the Applicant respectfully submits that it would not be obvious to combine the teaching of the ***Mitts*** or the ***Olson*** patent with the disclosure of the ***Takahashi, et al.*** patent, the combination clearly cannot result in the specifically defined anti-rotation elements as set forth in claim 11 and the Applicant respectfully requests withdrawal of the rejection of claim 11.

Finally, as set forth above, the subject matter of claim 17 has been combined with the subject matter of claim 18 and thus claim 17 is in condition for allowance.

The Applicant respectfully submits that claims 1 to 17 and 19 to 21 are in condition for allowance. Claims 22 and 23 have been cancelled subject to the restriction requirement and consideration of the filing of a divisional application. The Applicant therefore respectfully requests allowance of this application.

Although it is believed that no fee is due for the filing of this Amendment, the Commissioner is authorized to charge our Deposit Account No. 08-2789 for any additional fees or credit the account for any overpayments regarding this Amendment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.

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Date

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the attached **Amendment** is being facsimile transmitted to Examiner Saether Flemming, U.S. Patent and Trademark Office, at facsimile numbers (571) 273-8300 and (703) 872-9306 on October 24, 2005.

Tracy L. Smith

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